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APR 29 2002

In re Application of	:	OFFICE OF PETITIONS
Lorna Strachan et al	:	
Application No. 09/823,038	:	DECISION ON PETITION
Filed: March 28, 2001	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 11000.1037c3	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 8, 2002, to accept an unintentionally delayed claim under 35 USC § 120 or 121 or 365(c) for the benefit of one or more prior filed copending nonprovisional applications.

The petition is **granted**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the surcharge set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional; and
- (3) the specification must contain or be amended to contain a reference to each prior filed copending nonprovisional application or be included in an application data sheet (ADS) (37 CFR 1.76). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on March 28, 2001. This application was filed within twelve months of provisional Application No. 60/221,216, filed July 25, 2000, for which a claim for priority was made in the declaration at the time of filing of the subject application, although not in the manner specified by 37 CFR 1.78(a)(5). It is noted that the declaration also makes reference to two nonprovisional applications, namely, Application No. 09/383,586, filed August 26, 1999 (U.S. Patent No. 6,424,419) and Application No. 09/276,268, filed March 25, 1999 (now abandoned). While the claim for the benefit of the provisional application was noted by the U.S. Patent and Trademark Office, the Office did not note the claim for priority to the two above-noted nonprovisional applications.¹ Petitioner now seeks a claim for the benefit of priority to the two aforementioned nonprovisional applications, for which a claim for the benefit of priority also was not made in the manner specified in 37 CFR 1.78(a)(2). A further review of the file history indicates that the applications were copending at the time of their filing. A reference to the two prior nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, which was filed concurrently with the instant petition under 37 CFR 1.78(a)(3).

As noted above, the reference to the two prior filed nonprovisional applications was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2). Therefore, since the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(2), and having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(3) for acceptance of an unintentionally delayed claim for priority under 35 USC § 120, the petition to accept an unintentionally delayed claim for priority of

¹ The current procedure where a claim for priority under either 37 CFR 1.78(a)(2) or 1.78(a)(5) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. However, on the other hand, if the PTO does not note the claim for priority to the prior filed applications in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3) or 1.78(a)(6). In the instant case, the Office noted the claim for priority of provisional Application No. 60/221,216 in the oath or declaration, as shown by its inclusion on the filing receipt, but did not note the claim for priority for the two prior filed nonprovisional applications. Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

the two prior filed nonprovisional applications is granted as of the date of filing of the petition.

A corrected filing receipt which includes the priority claim to nonprovisional Application No. 09/385,586, filed August 26, 1999, and Application No. 09/276,268, filed March 25, 1999, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center AU for processing the amendment filed March 8, 2002 and for consideration by the examiner of the claim for the benefit of the prior filed applications.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt